



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/848,583	05/03/2001	Wolfgang Matthes	A-2820	8707

24131 7590 01/28/2008  
LERNER GREENBERG STEMER LLP  
P O BOX 2480  
HOLLYWOOD, FL 33022-2480

EXAMINER
----------

PRONE, JASON D

ART UNIT	PAPER NUMBER
----------	--------------

3724

MAIL DATE	DELIVERY MODE
-----------	---------------

01/28/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

09/848,583

Applicant(s)

MATTHES ET AL.

Examiner

Jason Prone

Art Unit

3724

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 27 December 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-4,6-11 and 14 is/are pending in the application.
- 4a) Of the above claim(s) 11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4,6-10 and 14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 August 2007 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Specification***

1. The amendment filed 14 August 2007 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: is the labeling of the knife of the first cutting station with the number "3" thereby making the sentence "The knives 3 are pressed against the knife 13 during the cutting operation" on page 10 lines 23-24 of the specification indefinite. It is unclear how the 1<sup>st</sup> cutting station knife interacts with knife 13 and there is no support that this 1<sup>st</sup> cutting station knife does interact with knife 13.

Applicant is required to cancel the new matter in the reply to this Office Action.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. To the degree the specification as a whole supports the claims even though the specific structure of the specification at issue is not claimed, claims 1-4, 6-11, and 14 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The

Art Unit: 3724

specification provides no support on how the newly labeled blade interacts with knives 13. Using applicants newly submitted Figure 1 along with original Figure 2, it appears knives 13 are directly underneath the original labeled knives. Therefore, it is unclear how the newly labeled knife could interact with knives directly underneath the original knives. Applicant admits that this interaction is not shown. Also, the specification does not explain how the newly labeled knife interacts with knives 13, it is therefore unclear what structure allows the newly labeled knife to interact with knives that are directly underneath the original labeled knives. Especially since the newly labeled knife represent a cutting station that is separate from the original labeled knives.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-4, 6, 7, 10, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ito (4,922,773) in view of Besemann (4,523,502) and in view of Boss (6,536,319). In regards to claim 1, Ito discloses the invention including a cutting station (12, 22, 49), a transport device (53) having a course of motion (Fig. 4), a first drive for driving the transport device (57), a stroke device (14 and 24) for moving knives (13 and 23) in a knife motion for performing the trimming of the margins (Column 8 lines 20-25), a second drive for driving for driving the stroke device (Drive mechanism (not shown) in

Art Unit: 3724

Column 8 lines 20-21), and the first drive and the second drive being separate (57 is clearly independent from Drive mechanism (not shown)).

In regards to claims 2 and 3, Ito discloses the cutting device is capable of trimming margins of joined/stitched-together sheets of paper (7).

In regards to claim 4, Ito discloses the control system includes a first and second control unit (Fig. 6), the first drive being linked to the first control unit (Fig. 6), a second drive being linked to the second control unit (Fig. 6), and a connection linking the first control unit to the second control unit (73).

In regards to claims 6 and 7, Ito discloses the first drive is connected by the first control unit and the second drive by the second control unit to a machine control unit (74) and the machine control unit had a human-machine interface (71 and 72).

In regards to claim 10, the drives are motors (57 and drive mechanism) and at least one of the control units has a programmable logic controller (75 and 76).

However, Ito discloses 2 separate drives and it could be assumed that the entire apparatus including the 2 separate drives are controlled by one central computer or power source especially since the cutter must be synchronized with the conveyor, however Ito fails to disclose this fact and therefore fails to disclose both drives being connected to the other via a control system for setting the course of motion of the transport device to the knife motion as a function of product format.

Besemann teaches it is old and well known in the art of tools that include a transfer drive and a cutter drive to incorporate both drives being connected to the other via a control system for setting the course of motion of the transport device to the knife

Art Unit: 3724

motion as a function of product format (Column 2 lines 30-37). Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention to have provided Ito with one control for both drives, as taught by Besemann, to allow both drives to be controlled from the same station and because all claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective function and the combination would have yielded predictable results.

Also, Ito fails to disclose a first cutting station having a first cutting station having a first cutting knife, a second cutting station following the first cutting station in a transportation direction and receiving products from the first cutting station, the second cutting station having further cutting knives, the stroke device moves the knives of both stations, and the first cutting knife is perpendicular to the transport direction and the further knives are parallel to the transport direction, the first cutting station has a cutting knife, the second cutting station having cutting knives, and the first cutting knife is perpendicular to the transport direction and the further knives are parallel to the transport direction.

Boss teaches it is old and well known in the art of three-sided trimmers to incorporate a first cutting station (A), a second cutting station following the first cutting station in a transportation direction and receiving products from the first cutting station (B), the stroke device moves the knives of both stations (69), the lead knife as perpendicular to the transport direction (2) followed by the two knives parallel to the transport direction (6, 6'). Therefore, it would have been obvious to one of ordinary skill

Art Unit: 3724

in the art, at the time of the invention, to have provided Ito with 2 cutting stations, as taught by Boss, because all claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective function and the combination would have yielded predictable results.

6. Claims 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ito in view of Besemann and in view of Boss as applied to claims 1 and 4 above, and further in view of Cannon et al. (4,553,080). Ito in view of Besemann and in view of Boss disclose the invention including the first and second drives are motors (57 and drive mechanism in Ito).

However, Ito in view of Besemann and in view of Boss fail to disclose position transducers connected to the first control unit and drive and to the second control unit and drive. Cannon et al teaches that it is old and well known to exchange encoders for position transducers (Background of the Invention). Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided Ito in view of Besemann and Boss with position transducers instead of encoders, as taught by Cannon et al., to provide more a less complex and cheaper apparatus and because all claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective function and the combination would have yielded predictable results.

***Response to Arguments***

7. Applicant's arguments with respect to claims 1-4, 6-10, and 14 have been considered but are moot in view of the new ground(s) of rejection.
8. The specification does not provide any explanation with regards on how the newly labeled blade interacts with item 13. Applicant admits that this interaction is not shown. It is also noted that it is the amendment to Figure 1 that is considered the new matter (addition of reference numeral 3)

### ***Conclusion***

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason Prone whose telephone number is (571) 272-4513. The examiner can normally be reached on 8:00-5:30, Mon - (every other) Fri.

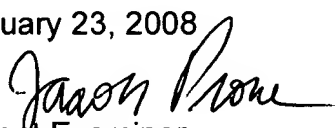


Art Unit: 3724

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Boyer D. Ashley can be reached on (571) 272-4502. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

January 23, 2008

  
Patent Examiner  
Jason Prone  
Art Unit 3724  
T.C. 3700